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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,720	02/19/2004	Jack T. Oldham	1684-6036US (484-28684-US)	7639
24247	7590	05/18/2007	EXAMINER	
TRASK BRITT			BOMAR, THOMAS S	
P.O. BOX 2550			ART UNIT	
SALT LAKE CITY, UT 84110			PAPER NUMBER	
			3672	
			MAIL DATE	DELIVERY MODE
			05/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/783,720

Applicant(s)

OLDHAM ET AL.

Examiner

Shane Bomar

Art Unit

3672

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 May 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 1-9, 11-74, 190 and 192.
Claim(s) objected to: _____.
Claim(s) rejected: 179-186, 189, 191 and 193.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). 3/23/07
13. ☐ Other: _____.


Jennifer H. Gay
Primary Examiner

Continuation of 3. NOTE: The Applicant states that the amendments do not raise new issues or require a further search, and that the amendments should be entered for Appeal purposes. However, it is clear that the amendments to claims 179, 191, and 193 do raise new issues requiring further consideration and/or search. The amendment to claim 179 has changed the phrase "disposed on the nose portion" to "extending from the nose portion", wherein "extending from" places the structures in a very specific location and configuration, whereas "disposed on" meant that the structures could be at any location or relation to the nose. The amendment to claim 191 has more specifically defined the position and structure of the groove, which was never previously claimed or considered. The amendment to claim 193 has added the limitation of a container for the reactive chemical that was also never previously claimed or considered. Furthermore, the amendment to claim 180, wherein "of a casing string" was added after "a casing section", appears to be merely a clarification amendment because the scope of the claim has not been changed to place the claim in condition for allowance (i.e., when casing section 32 is attached to the casing string, it is clearly part of said casing string).

Continuation of 11. does NOT place the application in condition for allowance because: Claim 189 was not amended because, as asserted by the Applicant, Strong et al do not disclose the limitation of the at least one second cutting element being in rotational alignment with at least one first cutting element. The Applicant refers to specific sections of the Applicants specification to show what the definition of "rotational alignment" is, but such a definition has not been incorporated into claim 189 in such a way to differentiate it from Strong et al. The Applicant further states that cutting elements on the same blade (as is the case in Strong et al) may, in some instances, be in rotational alignment, which appears to confirm the Examiner's stance. If the cutting elements of Strong et al are in longitudinal alignment when at rest, then why would they not be in rotational alignment when the bit rotates? Without specific limitations that positively define the "rotational alignment" limitation, the rejection must still be considered valid.